REMARKS/ARGUMENTS

1.)   Claim Amendments

In the Applicants' response to the prior office action, claim 50 was amended to include the limitations of claims 51 and 52, claim 67 was amended to include the limitations of claims 68 and 69, and claim 83 was amended to include the limitations of claims 84 and 85. In amending claims 67 and 83, however, the Applicants made an error and introduced the limitations of claims 68 and 84, respectively, twice – which the Examiner noted in the final office action. The Applicants have corrected that error in the amendments submitted herein.

In order to present the claim elements in an order in which the invention can be more directly understood, the Applicants have amended claims 50, 67 to move the final "wherein" limitations up to the element to which they relate. That amendment of the claims **does not** change the subject matter or scope of the claims, but only presents the claim limitations in a different order.

Claims 50, 53-57, 67, 70-81, 83 and 86-97 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.)   Claim Objections

The Examiner objected to claims 67 and 83 were objected to for the repetition of a claim element. As noted *supra*, the Applicants have corrected the error introduced in the response to the final office action, wherein it was intended to amend claim 67 to include the limitations of claims 68 and 69, and claim 83 to include the limitations of claims 84 and 85. The Applicants, therefore, respectfully request that the Examiner withdraw the objection to claims 67 and 83, as corrected herein.

3.)   Claim Rejections – 35 U.S.C. §102(b)

The Examiner has maintained the rejection of claims 50, 53-57, 67, 70-81, 83 and 86-97 as being anticipated by Wallentin, *et al.* (U.S. Patent No. 6,594,238). The Applicants traverse the rejections.

It is important to remember that anticipation requires that the disclosure of a single piece of prior art reveals <u>every</u> element, or limitation, of a claimed invention. Furthermore, the limitation that must be met by an anticipatory reference are those set forth in each statement of function in a claims limitation, and such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. Wallentin fails to disclose each and every limitation of claims 50, 53-57, 67, 70-83 and 86-97 and, therefore, those claims are not anticipated thereby.

Claim 50, as previously amended to include the limitations of claims 51 and 52, and as amended herein to move those claim limitations, recites:

> 50. A method in a User Equipment (UE) for initiating a data transfer from the UE in a Universal Mobile Telecommunications System (UMTS) terrestrial radio access network (UTRAN), wherein the UTRAN comprises at least one Radio Network Controller (RNC) connectable to the UE that is capable of being in the states UTRAN Registration Area Paging Channel (URA PCH), Cell Paging Channel (CELL PCH) or Cell Dynamic Host Configuration (CELL DCH), said method comprising the steps of:
>   introducing delay reducing information in<u>to</u> a data transfer initiating message by the UE<u>, wherein the data transfer initiating message is an uplink cell update message transmitted by the UE and wherein the delay reducing information comprises information indicating whether the traffic volume of the data to be transmitted is above a pre-configured threshold</u>;
>   transmitting the data transfer initiating message by the UE;
>   receiving a message from the RNC comprising information for transferring the UE from the URA PCH or the CELL PCH state directly to the CELL DCH state by means of the delay reducing information in the data transfer initiating message. (emphasis added)

The Applicants' invention is characterized by a data transfer initiating message including delay reducing information. In particular, the data transfer initiating message is an uplink cell update message transmitted by a User Equipment, wherein the delay reducing information comprises information if the traffic volume of the data to be transmitted is above a pre-configured threshold. Wallentin fails to disclose at least those aspects of the claimed invention.

Examiner's Response to Applicants' Prior Arguments

In responding to Applicants' arguments, the Examiner states that Figure 8 of Wallentin and the corresponding text at Column 8, lines 55-80, discloses "the mobile station signaling the controller to make the connection state change and in turn the controller to make the connection state change . . ." The Examiner, however, does not address the fact that, according to Applicants' claimed invention, a data transfer initiating message is transmitted by a UE to an RNC; <u>the message includes delay reducing information comprising information that indicates whether the traffic volume of the data to be transmitted is above a pre-configured threshold</u>. The RNC, <u>*in turn*</u>, controls transferring the UE from one state to another, based on the information received from the UE.

Referring to Figure 8 and column 8, lines 26-60, of Wallentin, it can be seen that a connection state selector (CSS) is provided in <u>**each**</u> RNC and MS. <u>**Each**</u> RNC and MS also include measurement units, and connection queues 71 and 81 are provided in <u>**both**</u> the RNC and the mobile station which store current data packets to be sent over the connection. In particular, it is noted that Wallentin teaches:

> "When a connection state selector determines that a connection state change is necessary, it sends a signal to a <u>corresponding</u> controller, *i.e.*, the RNC controller 75 or the mobile station controller 82. The respective controller handles the signaling over the radio interface in order to make the connection state change." (emphasis added)

In other words, measurements are done in <u>**each**</u> of the RNC and MS, and connection state changes are made in <u>**each**</u> - <u>**independent of the other**</u>. Thus, in contrast to the claimed invention, Wallentin does not teach measurement done <u>**in the UE**</u> and decision to change state <u>**in the RNC**</u> <u>***as a function of information transmitted from the UE to the RNC***</u>. That distinction was added to independent claim 50 by amending it to include limitations from dependent claims 51 and 52.

Wallentin *does* describe a solution where a decision to change state is based on the value of the traffic volume. Wallentin, however, appears to assume that the traffic volume is available <u>in the node</u> <u>**that makes the decision**</u> <u>to change state</u>. Wallentin, however, does not describe <u>how</u> such information is <u>provided to the node</u>. According to

Applicants' claimed invention, the traffic volume measurement **is done in the UE**, while the decision to change state **is done in the RNC**. This is a clear distinction of the claimed invention over the teachings of Wallentin. Furthermore, the problem the Applicants' invention solves, over the teachings of Wallentin, is <u>how to get such information to the RNC</u> – noting that there can be limited or no available bandwidth in the signaling message to carry such traffic volume measurement information. The Applicants' invention solves the problem by having the <u>UE make a comparison between the traffic volume and **a threshold**</u>, and *then* the **outcome of the comparison** <u>is signaled to the RNC</u> in the data initiating message. Transmitting the result of such a comparison, performed in the UE, is more efficient than transmitting the traffic volume measurement information to the RNC and performing a comparison there; *i.e.*, the Applicants' invention allows for a much smaller message. Wallentin fails to teach that solution. Therefore, Wallentin fails to anticipate claim 50.

Whereas independent claims 67 and 83 recite limitations analogous to those of claim 50, they are also not anticipated by Wallentin. Furthermore, whereas claims 53-57, 70-81 and 86-97 are dependent from claims 50, 67 and 83, respectively, and include the limitations thereof, those claims are also not anticipated by Wallentin.
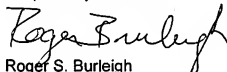
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CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 50, 53-57, 67, 70-81, 83 and 86-97.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

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